



MAY 17 2002

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In re Application of:	:	DECISION ON
RHODES ET AL.	:	PETITION
Application No.: 09/831,579	:	UNDER 37 CFR 1.42
PCT No.: PCT/AU99/00917	:	AND 37 CFR 1.47(a)
Int. Filing Date: 22 October 1999	:	
Attorney's File No.: 1037BP-1	:	
For: BIO-OXIDATION PROCESS AND APPARATUS	:	

This decision is in response to applicant's petition under 37 C.F.R. 1.47(a), filed 21 December 2001, to accept the above-identified application without the signature of co-inventor Richard Winby.

#### **BACKGROUND**

On 22 October 1999, applicants filed international application PCT/AU99/00917, which claimed a priority date of 18 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau. A Demand for international preliminary examination, in which the United States was elected, was timely filed on 04 May 2000. Accordingly, the thirty-month period for meeting the requirements for entry into the national stage expired at midnight on 18 May 2001.

On 11 May 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic filing fee and a FIRST preliminary amendment. Applicants did not submit an oath or declaration of the inventors (35 U.S.C. 371(c)(4)).

On 21 June 2001, the United States Designated/Elected Office (PTO) mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) was required as well as the surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)). Applicants were given a TWO (2) MONTH period from the mail date of the Notification to properly respond, with extensions of time obtainable under 37 C.F.R. 1.136(a).

On 21 December 2001, applicants timely filed the instant petition under 37 CFR 1.47(a) which was signed by Robert D. Traver and included a certificate of mailing dated 21 December 2001, a declaration under 37 CFR 1.63 which was unsigned only by co-inventor Winby, declarations in support of the instant petition asserted by Richard Baddeley and Dr. Paul Miller, respectively, a petition for a four month extension of time for reply within the sixth month which ended at midnight of 21 December 2001, the surcharge as required under 37 CFR 1.492(e), and the requisite fee for filing the instant petition.

### DISCUSSION

37 CFR 1.42 states:

*In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of the application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention.*

37 CFR 1.497(b)(2) states:

*If the person making the oath of declaration or any supplemental oath or declaration is not the inventor (37 CFR 1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.*

Applicants have failed to satisfy the requirements under 37 CFR 1.497(b). The Declaration does not provide the citizenship, residence and mailing address of the legal representative, Mrs. E.A. Winby.

MPEP 409.03(c) states, in part:

*...the last known address of the legal representative must be given (see MPEP § 409.03(e)).*

Applicants have satisfied the requirement in MPEP § 409.03(e).

37 CFR 1.47(a) states:

*If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the non-signing inventor. The oath or declaration in such an application must be accompanied by a petition*

*including proof of the pertinent facts, the fee set forth in § 1.17(i) and the last known address of the non-signing inventor. The Patent and Trademark Office shall, except in a continued prosecution application under § 1.53(d), forward notice of the filing of the application to the non-signing inventor at said address and publish notice of the filing of the application in the Official Gazette. The non-signing inventor may subsequently join in the application on filing an oath or declaration complying with § 1.63.*

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the non-signing joint inventor refuses to execute the application, (3) a statement of the last known address of the non-signing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicants have satisfied items (1) and (3) above.

Regarding item (2) above, MPEP 409.03(d) (August 2001) states in part:

*Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.*

*Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney.*

*When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.*

*When it is concluded by the 37 CFR 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a non-signing inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.*

The supporting documentation submitted with the petition does not provide clear evidence that Mrs. Wimby's conduct constitutes a refusal.

In the declaration of Richard Baddeley, paragraph 5 states that "Mrs. Winby expressed her reluctance to give her signature to the required declaration at that time" and that she "did not make

a specific written or oral refusal." See also paragraph 8 which states that Mrs. Winby has not made an express oral refusal to sign the declaration documents.

In the declaration of Dr. Paul Miller, paragraph 5 states that "Mrs. Winby expressed her reluctance to give her signature to the relevant papers due to the unfortunate experiences with signing documentation related to Mr. Winby's death." See also paragraph 9 which states that "Mrs. Winby. persisted in her reluctance to sign the forms."

Mrs. Winby's "reluctance," as set forth in the supporting declarations, to sign the necessary papers coupled with the supporting declarations showing that Mrs. Winby has not given an express oral or written refusal to accept the papers and sign the papers does not clearly constitute a "refusal" as set forth in MPEP 409.03(d).

Regarding item (4) above, the declaration is defective for reasons discussed above.


In that items (2) and (4) have not been satisfied, the present petition under 37 CFR 1.47(a) may not properly be granted at this time.


### **CONCLUSION**

For the reasons above, the petitions under 37 CFR 1.42 and 37 CFR 1.47(a) are both **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Failure to timely submit the proper reply will result in **ABANDONMENT**. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

  
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